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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,543	07/07/2000	Makoto Funabashi	1982-0153P	9387

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EXAMINER

CLEVELAND, MICHAEL B

ART UNIT PAPER NUMBER

1762

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,543

Applicant(s)

FUNABASHI, MAKOTO

Examiner

Michael Cleveland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 14-19 is/are allowed.
6) ☒ Claim(s) 1-4, 6-13 and 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/16/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-7, 9-10, 12-13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (U.S. Patent 4,028,550, hereafter '550) in view of Leblans et al. (U.S. Patent 5,360,578, hereafter '578).

'550 teaches dispersing a binder and a barium fluorohalide phosphor in a dispersion medium (col. 3, line 65-col. 4, line 15), wet classifying the phosphor (col. 4, lines 10-12), and applying the material to a support and drying to form a phosphor layer (col. 4, lines 31-41). Applicant has defined a "soluble" binder as "having solubility sufficient for preparing the phosphor layer coating liquid which can be applied for forming a phosphor layer" (paragraph bridging pages 12 and 13 of the specification). Thus, because the binder of '550 is applied to form a phosphor layer, it meets Applicant's definition of soluble.

'550 does not teach that the specific order of adding phosphor to the dispersion medium, wet classifying, and then adding the binder. However, it has long been settled that the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. See, for instance, *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) and MPEP 2144.04.II.C. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time the invention was made to have performed the steps in the order of adding the phosphor, wet classifying, and adding the binder instead of adding the binder, adding the phosphor and wet classifying with the expectation of similar results and with a reasonable expectation of success because the final coating slurry would have been substantially identical.

'550 also does not teach that the phosphor is calcined. In fact, '550 is silent as to the method of preparing the barium fluorohalide phosphor. '578 teaches that barium fluorohalide phosphors may be prepared by mixing the appropriate components and then calcining (col. 6, line 50-col. 7, line 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed the process of '550 using a calcined phosphor with a reasonable expectation of success because '578 teaches that calcining is a conventional method of making such phosphors.

The particles are sieved by passing through meshes (col. 4, line 50-col. 5, line 7). Particles over 40 microns in size are undesired (col. 3, lines 30-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a maximum final mesh size of 40 microns, which is less than 50 microns, in order to achieve the desired particle size range.

Claim 2: The dispersion medium may be organic ('550, col. 4, lines 8-9).

Claim 6: Although the nomenclature is different, the phosphors disclosed by '550 (col. 2, lines 26-30 and Example 1) appear to be covered by applicant's formula. '578 uses a formula more easily comparable to Applicant's: The formula for useful phosphors is given at col. 2, lines 6-17. "a" in claim 6 is equivalent to "x" of the formula of '578, and "x" of claim 6 is equivalent to "y" of '578. '578's "x", "M^{II}", and "A" overlaps Applicant's claimed ranges for their equivalents: "a", "M^{II}", and "Ln", respectively. '578's "X" and "y" are identical to Applicant's claimed ranges for their equivalents: "X" and "x", respectively. Applicant's "b", "c", and "d" are 0 in the formula of '578, which is within Applicant's claimed ranges for them.

Claim 9: The wet classification may be by filtration ('550, col. 4, lines 10-11).

Claim 13: '550 teaches a binder to phosphor ratio of about 1:14 (Example 1).

Claims 3 and 12: '578 teaches that it is desirable to classify the particles in order to remove both large (greater than 40 microns) and small (smaller than 2 microns) particles for the reasons given at col. 3, lines 31-56. The particles may be wet sieved to remove the large particles (col. 4,

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line 56-col. 5, line 13). The undesired small particles may be removed “before drying”, which appears to refer to the wet classification step, by sedimenting the desired particles gravitationally or centrifugally and removing the liquid (i.e., decanting) containing the fine particles continuously (col. 5, lines 34-43).

Claim 7: ‘578 teaches a ratio of approximately 20 parts phosphor per 100 parts dispersing medium for sieving (e.g., Example 1, Example 10).

Claim 9: ‘578 teaches that the sieving may occur by vibrating the meshes (i.e., screens) (col. 4, lines 50-68).

Claim 10: ‘578 teaches that the particles may be sieved through a plurality of stages having decreasing mesh size (col. 4, line 56-col. 5, line 13).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss ‘550 in view of Leblans ‘578 and further in view of Jamil et al. (U.S. Patent 5,772,916, hereafter ‘916).

Weiss ‘550 and Leblans ‘578 teach the limitations of claim 1, as discussed above. They do not teach that the wet classification a plurality of times. However, ‘578 does teach a desired size distribution to achieve (col. 4, lines 13-25).

Jamil ‘916 teaches sieving a phosphors a plurality of times in order to classify the phosphors to a desired size (col. 11, lines 47-62). The implication is that the repeating process aids in the goal of ‘916 of achieving a narrow phosphor particle size distribution (col. 6, lines 10-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have repeated the sieving process of ‘578 in order to have achieved better control (i.e., a narrower distribution) of the particle size, as taught by ‘916.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss ‘550 in view of Leblans ‘578 and further in view of Ochiai (U.S. Patent 4,501,971, hereafter ‘971).

Weiss ‘550 and Leblans ‘578 teach the limitations of claim 1, as discussed above.

Claim 8: ‘550 teaches mixing by ball milling for 16 hours. ‘578 teaches that the phosphor is dispersed in the medium by stirring vigorously (i.e., turbulently) (col. 11, lines 59-63). However, it is silent as to the stirring mechanism and therefore does not suggest that the stirring occurs with a mixing blade. ‘971 teaches that phosphor dispersions may be thoroughly

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mixed by using a propeller mixer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a propeller (i.e., a mixing blade) mixer as the particular mixing mechanism of '550 and '578 with a reasonable expectation of success.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss '550 in view of Leblans '578 and further in view of Hultsch et al. (U.S. Patent 4,405,454, hereafter '454).

Weiss '550 and Leblans '578 teach the limitations of claim 1, as discussed above. They do not teach that the classification occurs by pressure filtration. However, '578 indicates that a wide variety of methods are suitable for classifying the particles (col. 4, lines 45-49). '454 teaches that pressure filtration is another method suitable for classifying particles from dispersions (Abstract, col. 2, lines 56-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used pressure filtration as the wet classification method of '550 and '578 with the expectation of the similar results.

Allowable Subject Matter

7. Claims 14-19 are allowed for the reasons already of record.

Response to Arguments

8. Applicant's arguments filed 5/16/2005 have been fully considered but they are not persuasive.

Applicant's declaration under 37 CFR 1.132 filed 4/12/2005 is insufficient to overcome the rejection of claims 1-4, 6-13, and 20 based upon Weiss and Leblans as set forth in the last Office action because: it is not commensurate in scope with the claims, which are not limited to the particular phosphor, the particular calcining process, the particular classification process, the particular slurry materials, binder, and concentrations; and which do not recite the provision of a reflective undercoating layer nor a protective film.

Applicant argues that there is no discussion of *In re Burhans* or *In re Gibson* and that the application in question is directed to a more sophisticated technology than the production of

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whole wheat flour or mixing brake shoe fillers. The current case is very similar to that of *In re Burhans* in that the art demonstrates that each of the claimed steps is known in the art, but Applicant claims them in a different order. As stated in *In re Burhans*:

Appellant contends that the references taken singly or together do not teach his characteristic four steps which are new in the art and which are necessary to obtain the desired result. There is no merit in the point here in the absence of any proof in the record that the order of performing the steps produces any new and unexpected results. See *In re Gibson*, 17 C.C.P.A. (Patents) 1090, 39 F.2d 975, 5 USPQ 230 ; *In re Lang et al.*, 25 C.C.P.A. (Patents) 1322, 97 F.2d 626, 38 USPQ 187 ; *In re McKee*, 23 C.C.P.A. (Patents) 1187, 83 F.2d 819, 29 USPQ 493 .

Applicant argues that the present case is directed to a more sophisticated technology. The argument is unconvincing because it is clear from the above citation that the principle is recognized to apply regardless of the area of technology because the cases cited by the court are from widely disparate areas: brake shoes (*Gibson*), dietary liquids (*Lang*), and wrapping meat (*McKee*). Therefore, it is clear that the principle applies regardless of the nature of the technology. Furthermore, the nature of the steps in the present case are very simple mechanical processes of mixing and wet classifying.

Applicant argues that the Examiner has not compared the degree of unpredictability of the factors involved in the present case with those of *Burhans* or *Gibson*. There is no evidence currently of record of unpredictability regarding the order of the mixing and classifying steps in the present application.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Rabatin* (U.S. Patent 4,360,571, Example 1), *Alles* (U.S. Patent 2,819,183, col. 2, lines 1-22), and *Rabatin* (U.S. Patent 4,208,470, Example 1) also show examples of wet classification of slurries of a phosphor and a binder before applying them to form a panel.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


Michael Cleveland
Primary Examiner
Art Unit 1762

7/6/2005